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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* GEOFFREY RHOADS
11

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13 Appeal 2010-004619
14 Application 09/574,726
15 Technology Center 3600
16

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18 Oral Hearing Held: June 7, 2011
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20
21 Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
22 R. MOHANTY, *Administrative Patent Judges*.
23

24 APPEARANCES:
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35 The above-entitled matter came on for hearing on Tuesday,
36 June 7, 2011, commencing at 10:10 a.m., at the U.S. Patent and Trademark
37 Office, 600 Dulany Street, Alexandria, Virginia, before Victoria L. Wilson,
38 Notary Public.
39

P R O C E E D I N G S

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THE USHER: Calendar number 14. Appeal number 2010-4619.

Mr. Meyer.

JUDGE CRAWFORD: Good morning, Mr. Meyer.

MR. MEYER: Good morning. I'm here with my colleague from Foley & Lardner, Troy Smith.

MR. SMITH: Good morning.

MR. MEYER: He's of record, so if you have any questions for him, ask him, as well.

May it please the Court. Thank you very much for your time this morning. I thought it would be most productive, since we think the issues are fairly straightforward in this case, to start by seeing if you have any questions on any of the issues --

JUDGE CRAWFORD: Good way to start.

MR. MEYER: -- in this appeal. Because I think this could possibly be very quick.

JUDGE CRAWFORD: Okay. I see that you are relying in response to these 112 rejections.

MR. MEYER: I'm sorry?

JUDGE CRAWFORD: The 112 rejections.

MR. MEYER: Yes.

JUDGE CRAWFORD: So you're going back to page eight of the spec.

MR. MEYER: Correct.

JUDGE CRAWFORD: I don't see that at page eight of the spec. I don't see --

1 you know what I'm -- what I'm struggling with here is how it says in this
2 claim, "adaptively changing values of the perceptible parts of the visual or
3 audio signals by varying amount that depends on the values of the perceptible
4 parts." That's what I'm not -- I don't --

5 MR. MEYER: Right.

6 JUDGE CRAWFORD: I'm kind of seeing where the Examiner is coming
7 from here.

8 MR. MEYER: Okay. The -- well, one line I draw your attention to is the
9 sentence that says, "various techniques for perceptively adapting, including,
10 are known. For example, some tie the amplitude of the encoded signal to the
11 instantaneous amplitude of the music."

12 JUDGE CRAWFORD: Well, see --

13 MR. MEYER: So --

14 JUDGE CRAWFORD: -- now maybe I'm not reading this claim right. I'm
15 reading the claim to say that you're varying the actual visual and audio signals.
16 It says, "changing the values of the visual and audio signals."

17 MR. MEYER: Correct.

18 JUDGE CRAWFORD: That doesn't seem like what you're disclosing here.

19 MR. MEYER: Yeah, the visual or the audio signal -- music would be an
20 example of an audio signal.

21 JUDGE CRAWFORD: Right.

22 MR. MEYER: So they're varying the amplitude of that signal, the music
23 signal.

24 JUDGE CRAWFORD: It says you're tying the amplitude to the signal but it
25 doesn't say you are varying the signal.

1 JUDGE FISCHETTI: One can follow from the other and it's not clear who's
2 following and who's leading.

3 JUDGE CRAWFORD: I mean because perhaps you are varying your
4 encoding. I mean if it's a soft part of the music, you're making, you know, it
5 less perceptible, but I'm reading the claim to say that you actually are varying
6 the -- the audio and visual signals, and that's what I'm having problems seeing
7 either here or in the '260.

8 MR. MEYER: Correct. Yeah, in the '260 patent -- well, there we provide
9 examples of the pixels and the pixels are the visual elements of a visual signal.

10 JUDGE CRAWFORD: Okay. Tell me -- because I don't see it in the spec
11 so --

12 MR. MEYER: Okay. Well, let me get a copy of the '260 patent here.

13 JUDGE CRAWFORD: Okay.

14 MR. MEYER: So if you look, for example, in column 8 at equation 3, which
15 is a line, roughly line 21 --

16 JUDGE CRAWFORD: Okay.

17 MR. MEYER: -- there is -- this is one embodiment in which the -- the signal,
18 this is -- and this -- this equation is generalized to be applicable to signals
19 which could be an image or an audio, which is explained other -- in other
20 portions of the specification. The equation is the -- the output, which is this
21 distributable signal, the $V_{DS} - DISTN, M$, is equal to the original signal
22 plus the composite, which is the -- an aggregate of watermark -- of the
23 watermark encoding signal times one factor, which is X , times the square root
24 of -- of another quantity, which is a function of the original signal.

1 JUDGE CRAWFORD: See, this -- this would have been a lot easier if you
2 explained this.

3 MR. MEYER: Yeah, I think that I -- I tried to do this --

4 JUDGE CRAWFORD: You kind of like -- you reference to this patent in
5 certain places and then I'm going there, I'm like -- so explain how that
6 actually -- how this equation actually discloses that.

7 MR. MEYER: Yeah. So the -- the equation references that the -- under the
8 square root symbol, you have the term "V original," so what it is doing is
9 saying that I'm going to multiply the watermark, which is V composite, times
10 this function of the original signal, so -- and that's essentially what that equates
11 to is a scaling factor of the amplitude of the watermark at that particular
12 sample in the image.

13 JUDGE CRAWFORD: And so the V -- I can't even read it. One side of the
14 equation has the original signal changed by the watermark and then does it
15 equal to the signal that we -- you output?

16 MR. MEYER: Yeah, the watermark -- the output signal is the -- it's V sub
17 DIST, which is the distributable image in this case, if you are talking about a
18 visual signal.

19 JUDGE CRAWFORD: Okay. I got that part now. All right.
20 Next question.

21 MR. MEYER: Sure.

22 JUDGE CRAWFORD: Why do you think you have priority? I don't see any
23 place where the Examiner gave you priority going back to '260, which you
24 would have to be accorded by the Examiner. The Examiner says, "I never did
25 that."

1 MR. MEYER: Yeah, that's -- that's perplexing to us because we -- we had an
2 amendment. This is a case that was filed prior to November 29th, 2000, so the
3 priority claim came in in an amendment.

4 And, Troy, do you have the amendment? We filed --

5 JUDGE CRAWFORD: I saw the amendment. It was in 2005. I saw the
6 amendment.

7 MR. MEYER: And the application data sheet, did you see that, as well?

8 JUDGE CRAWFORD: Right. I saw where you say I claim a priority, I just
9 never saw where the Examiner entered it. And now the Examiner's saying he
10 didn't enter it, so --

11 MR. MEYER: Well, I -- the Examiner, in response to that -- to that -- that
12 amendment where we made -- we submitted it, he said, "Applicant's
13 arguments" -- this is in the office action --

14 JUDGE CRAWFORD: Yeah, I realize what you are saying but there is
15 nothing in the record to say that you were given priority. I mean I realize that
16 he -- he withdrew the rejection. Certainly I read that, also. But I don't see
17 anything there where it said that he gave you priority. I can't find in the record
18 where the actual spec was actually amended. So was that ever entered?

19 MR. MEYER: Well, I -- that's a -- I don't know the answer to that other than
20 to say that he said it was persuasive, I referred to it again in a subsequent
21 action and called the Examiner's attention to it saying I realize that I didn't see
22 it reflected in PAIR, so I said please, you know, acknowledge this.

23 And the Appeal Brief, it's interesting the Examiner says that the priority claim
24 is going to be -- requesting us to remove the amendment to the specification,
25 so I assume that he's kind of taking both sides of the fence on that.

1 JUDGE CRAWFORD: Where was that?

2 MR. MEYER: Yeah, that's --

3 JUDGE CRAWFORD: I don't think I -- but I think it's sort of a --

4 MR. MEYER: On page 16 of the Appeal Brief.

5 JUDGE CRAWFORD: You mean of the answer?

6 MR. MEYER: I'm sorry. The -- yeah, I misspoke. I apologize. Yeah, that

7 was page 16 of the answer at the last paragraph. "Applicant is required to

8 delete the reference to the prior file application from the first sentence of the

9 specification or the application data sheet." So I -- I think he's kind of having

10 it both ways. He's saying, "Well, I -- there was priority made but now I'm

11 saying there isn't co-pendency," and, obviously, that -- we're just responding to

12 the issue that there is -- he is attacking the co-pendency, which is, obviously,

13 not an issue, if you look at the claim, priority claim.

14 JUDGE CRAWFORD: I take your point there but it's kind of a technical issue

15 of whether or not that was actually entered and whether or not you were

16 accorded priority.

17 MR. MEYER: I don't know -- your Honor, you are correct. I mean I -- I don't

18 know what else I could have done to make sure that that priority claim was

19 entered. Everything in the record reflected to me that he was acknowledging

20 that priority claim and it was entered because he withdrew the rejection, he

21 went back and cited art that was before that date.

22 It wasn't until months and years later where he pulled this other reference out

23 and I called back his attention to the fact that we have a priority claim and that

24 then why is not prior art, but this was -- years had transpired in between the

1 time when he entered that earlier amendment in '05 and then later issued a
2 rejection.

3 JUDGE CRAWFORD: Well, where do you have that he entered the
4 amendment in '05? You certainly filed it.

5 MR. MEYER: Well, Troy, do you have the --

6 MR. SMITH: That's the office action response to the spec amendment.

7 JUDGE CRAWFORD: He didn't say anything about the -- he didn't say
8 anything in that office action about the amendment, he just withdrew the
9 rejection.

10 MR. MEYER: Well, he did say it was persuasive and it was the sole basis for
11 overcoming the prior art rejection.

12 JUDGE FISCHETTI: What's the date on that page -- paper, please?

13 MR. MEYER: The date of our amendment to the specification and submission
14 of an application data sheet was April 4th, 2005. It's stamped by the patent
15 office as received April 7th, 2005.

16 JUDGE CRAWFORD: So, then -- and the Examiner's response is when?

17 MR. MEYER: Oh, the -- you want the Examiner -- the date of the Examiner's
18 response?

19 JUDGE CRAWFORD: That was in June; right?

20 JUDGE FISCHETTI: Okay. Now, I see that you've put something into the
21 specification. Did that include the declaration, as well?

22 MR. MEYER: The --

23 JUDGE FISCHETTI: Was your oath and declaration amended, as well?

24 MR. MEYER: I don't recall. I don't -- I know that there was a -- an update to
25 the application data sheet.

1 JUDGE FISCHETTI: Isn't that the controlling document, the oath and
2 declaration that -- in which the priority is actually obtained?

3 MR. MEYER: I know of no statutory requirement that the oath needs to be
4 amended but I could be wrong about that.

5 JUDGE FISCHETTI: Well, wouldn't you have put it in at the first instance
6 if -- if it was -- if it was that important?

7 MR. MEYER: Well, the history of the case is such that we filed the
8 application and the first -- one of the earlier rejections in the case was a 102B
9 rejection over the Rhoads '260 patent, so while we may have thought about
10 priority at the time of filing, it was not -- it didn't hit us over the head until we
11 actually had a 102B rejection over this very reference which -- by one of the
12 inventors in this case.
13 So we looked at that, we studied the Examiner's rejection, studied the support
14 in the '260 patent and then took the position, which was deemed persuasive by
15 the office, that we were going to claim priority back to that -- that reference
16 that the Examiner was relying on for a 102B rejection. So it -- it was not at the
17 time of filing when we submitted the original oath.

18 JUDGE FISCHETTI: Is this a petitionable matter at the core level?

19 MR. MEYER: We don't think so. We think that the priority claim was, in
20 fact, entered, was deemed persuasive. The Examiner now is asking us to
21 remove it or to remove or delete a reference to it, so we assume that it's -- if
22 you are deleting something, it has to be there, according to his argument on
23 page 16 of the answer.

24 JUDGE CRAWFORD: It's just that I don't see it in this record and, so, I don't
25 think you have been accorded priority, from what I see. And perhaps that was

1 a mistake, I don't know, but whether or not you get priority, I believe, is a
2 petitionable matter, not an appealable matter.

3 MR. MEYER: Well, again, I think it appears to me that priority has been --
4 has been granted but, again, I don't --

5 JUDGE CRAWFORD: But there's nothing else that I missed?

6 MR. MEYER: I don't -- we did look at this issue in consultation with our
7 counsel, here co-counsel, and could not find any support for why this would --
8 what petition we would file here in this particular case. You know, it -- again,
9 this is kind of a blind side at the end of the day. We have had several actions.

10 JUDGE CRAWFORD: Yeah, I understand that. I guess the petition would be
11 that you should have been accorded priority and that the -- because the
12 Examiner is now arguing that you can't get priority, that it's not co-pending
13 and, you know, I just don't --

14 MR. MEYER: Well -- I'm sorry.

15 JUDGE CRAWFORD: I'm just -- I don't know what we can do at this level,
16 because I can't find anyplace in here where you were accorded the benefit.

17 MR. MEYER: I -- I have been prosecuting cases for a while and I don't know
18 if I have ever -- I mean I don't recall that that's something that is formally in
19 the written record in all cases. I mean you make a priority claim and it's --

20 JUDGE MOHANTY: There is a 181 petition for matters where there is no
21 specific, you know, situation -- no specific petition, you know, in the
22 MPEP181 petition for something not specific.

23 MR. MEYER: For the judge to waive the rules or something of that nature?

24 JUDGE MOHANTY: Yeah, I'm just not really sure that some of the issues in
25 this are really, quote, unquote, "ripe" for us to -- I'm not really sure that we can

1 -- I think the 181 petition might be the route you are going to have to go. I'm
2 not sure that you -- I'm sure you don't want to have to wait anymore but I
3 just -- I'm not really sure that priority can really be granted here in an Appeal
4 if the Examiner hasn't done it.

5 MR. MEYER: Well, one concern I -- we have is that, you know, what -- we
6 thought what our actions were reasonable in pursuing this because it does look
7 ambiguous to us on the record that -- about the priority claim, so if we are -- if
8 a petition has some time -- and I'm not sure -- I have to do some further
9 research -- if it has a time limitation to it, at the very least, we would want to
10 be granted some time to be able to submit the petition.

11 JUDGE MOHANTY: I'm sure that would be the case.

12 JUDGE CRAWFORD: I mean we'll look into it further but that's where I kind
13 of stopped and I said I don't think you have priority, so -- and because your --
14 your prior art rejections, your response is to go with this priority, so --

15 MR. MEYER: Sure. Yeah, and I just want -- perhaps is there an opportunity
16 to remand to the examiner to -- to correct the mistake, because I -- I really
17 think that this is a situation where he's taking advantage of the fact that he
18 didn't actually do the formal requirement of updating the record here and he's
19 kind of opportunistically three years later saying, "Okay. Now I didn't -- I
20 don't recall the priority," and of course he doesn't. He knows that there is a
21 priority claim that's made. He didn't reject it at the time. So it just seems -- it
22 seems unfair. I know that -- that doesn't mean much, perhaps, but --

23 JUDGE CRAWFORD: Oh, I think it does.

24 JUDGE MOHANTY: I think it does, too.

25 JUDGE CRAWFORD: So we will consider, you know, our options.

1 MR. MEYER: Okay.

2 JUDGE CRAWFORD: I just wanted to tell you that's kind of what -- the issue
3 that I have here.

4 MR. MEYER: No, that's fair and, late in the day, to the credit of our counsel
5 here, they started scratching their heads about this issue, as well.

6 We researched this hard on Friday. I mean I didn't even think about this
7 petitionable issue, frankly, until Friday and then I started looking; I could not
8 find anything about how we would have done it, what would have triggered it,
9 and I don't want sort of the -- now to be precluded from doing a petition if
10 that's the route that has to be done but I do feel like if the Examiner is saying
11 it's really an issue that there is priority but he doesn't see co-pendency, that's a
12 different issue than saying there is no priority at all. So I think he's --

13 JUDGE CRAWFORD: So isn't he saying -- he's saying both, though.

14 MR. MEYER: Well, I think he's doing both but that seems a little bit out of
15 both sides of the mouth to me because if it's priority and there's no
16 co-pendency, I think it's within your jurisdiction to -- to conclude there is
17 co-pendency, which there clearly is. If you think that -- that he's trumping
18 himself by saying there is no --

19 JUDGE CRAWFORD: Co-pendency, therefore, there's no -- there can be -- I
20 think the Examiner is saying, "I never granted priority and, in any case, you
21 can't get priority, period, because it's not co-pendency," and so --

22 MR. MEYER: Well, I think the record is pretty clear on the co-pendency
23 issue, that there is in the claim, and if you want to -- do you have any questions
24 on the co-pendency question?

25 JUDGE CRAWFORD: I don't.

1 MR. MEYER: Okay. I don't want to take anymore of your time on that issue
2 then. Thank you.

3 JUDGE MOHANTY: Don't the dates speak for themselves?

4 JUDGE CRAWFORD: Well, there's an issue -- there's an issue in this case
5 about an intermediate -- an intermediate application.

6 MR. MEYER: Priority is claimed to the '260 patent at issue here that we're
7 relying on through another application and that's -- that's well set out in our
8 application data sheet, our amended application data sheet and our -- and the
9 amendment to the specification.

10 JUDGE CRAWFORD: It's just not our call. That's what the -- that's what the
11 issue is.

12 MR. MEYER: Yeah.

13 JUDGE CRAWFORD: Now, as I said, I'm going to go and look into it some
14 more but when -- you know, when I was reading it, I was like, you know, I
15 don't know what we can do at this stage about this.

16 MR. MEYER: Yeah, and, like I said, I don't know what we could have done
17 differently either. We saw the acknowledgment of the -- of the priority claim,
18 or so we thought, we saw that PAIR -- the database wasn't updated, and we
19 made a subsequent request to have that updated, and -- but that, in our
20 experience, is not -- the database in PAIR doesn't necessarily correlate with
21 actual claims that have been made in the record, so --

22 JUDGE CRAWFORD: So you only have a few minutes. Do you want to
23 address the 102 over Danielle?

24 MR. MEYER: Sure. Danielle reference, this has a long history in this case
25 where we have been arguing back and forth. Danielle teaches the use of a

1 glyph technology and glyphs is a fairly well-known technology developed by
2 Xerox where machine readable information is encoded on a document by
3 making essentially slash marks on the document which can be made really
4 small and put in the margin so that you can't see it. Our claim argument on
5 claim 26 is pretty straightforward and fundamental. The claim requires a
6 music signal. The Examiner's argument is that because the glyph codes apply
7 to sheet music, which is a printed document, it -- he sees no reason why it can't
8 apply it to a music signal. We're obviously talking about an auditory signal
9 and so we don't see the relevance there and we think that's pretty
10 straightforward as set forth in our argument.

11 JUDGE CRAWFORD: Okay. All right.

12 Do you have any questions?

13 JUDGE FISCHETTI: No. I'm good. Thanks.

14 MR. MEYER: Thank you very much.

15 JUDGE CRAWFORD: All right. Thank you.

16 (Whereupon, the proceedings at 10:31 a.m. were concluded.)